

REMARKS

SUMMARY

Claims 1-23 have been rejected in the above-identified Office Action. In response to this, the claims 3, 4, 10-14, and 17-21 are cancelled. Claims 1,2, 5, 8, 15, 16, and 22 have been amended and claim 24 has been added. Accordingly, claims 1, 2, 4-9, 15, 16, and 22-24 are pending in the application. Reconsideration of the application is respectfully requested.

CLAIM OBJECTIONS

In “Objections,” item 2-3 on page 2 of the above-identified Office Action, the Examiner objected to claims 1-21 because of informalities, and to claims 15-21 because of lack of antecedent basis. In response, Applicants have amended claims 1,2, 5, 8, 15, 16, and 22 to remove the informalities and provide antecedent basis. Claims 3, 4, 10-14, 17-21 have been cancelled, obviating their objections. Therefore, the Applicants respectfully submit that the objections have been overcome.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In “Claim Rejections – 35 USC § 112,” item 4 on page 3 of the above-identified Office Action, claims 15-21 have been rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Since claims 15 and 16 have been amended and claims 17-21 have been cancelled, the problem recitation (“a machine-accessible media having associated data for distributing data”) no longer exists. Therefore, the Applicants believe that the pending claims 1, 2, 4-9, 15, 16, and 22-24 fulfill the requirement of 35 USC § 112.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101

In “Claim Rejections – 35 USC § 101,” item 5 on page 3 of the above-identified Office Action, claims 15-21 have been rejected as being directed to non-statutory subject

matter. In response, claims 15 and 16 have been amended and claims 17-21 have been cancelled. Claim 15 now recites a storage medium having a plurality of programming *instruction* configured to program a client.

Claims such as claim 15 are often referred to as “Beauregard claims”, in reference to the Federal Circuit Court’s decision in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995), in which the Federal Circuit held that a computer-readable storage device, e.g., a floppy disk or CD, containing a set of instructions that causes a computer to perform a process is patentable subject matter. The court held that such instructions, stored on an article, are not merely “printed matter” (i.e., software per se) and are accordingly patentable. Because claim 15 recites precisely the sort of article of manufacture that was held to be patentable under §101 in *Beauregard*, claim 15 is also patentable under §101. Claim 16 depends from claim 15, and accordingly is also patentable under §101 for the same reasons.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

In “Claim Rejections – 35 USC § 102,” item 4-7 on page 4-5 of the above-identified Office Action, claim 22 has been rejected as being anticipated by U.S. Patent No. 6,668,173 (hereinafter *Greene*) under 35 U.S.C. § 102(e).

The rejection has been noted and claim 22 has been amended. As amended, claim 22 claims a first instant messaging client comprising:

- a processor; and
- logic to be operated by the processor to
 - first receive a first location of the first instant messaging client,
 - second receive from an instant messaging server a second location of a second instant messaging client,
 - determine a proximity of the first and second locations, and
 - automatically execute an application program if the proximity meets a pre-determined threshold..

In contrast, *Greene* discloses that one or more wire or wireless devices (11, 13) which may act as IM clients, can determine their locations and transmit information such location information to an IM server(19). Nothing in *Greene* discloses “determine a proximity of the first and second locations” or “automatically execute an application program if the proximity meets a pre-determined threshold” by an IM client, as is claimed in claim 22. What *Greene* discloses is that the IM server “performs a position-to-location-tag translation that converts the position data into location tags,” which may also be performed by “a separate intermediate proxy server.” Even though such translation operations can be called “execution of an application program,” it is performed by a server instead of the IM clients, and is not based on the proximity of locations of IM clients. Therefore, *Greene* fails to disclose each and every feature of the amended claim 22.

Accordingly, the Applicants believe that the amended claim 22 is patentable over *Greene* under 35 U.S.C. § 102(e).

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

1. In “Claim Rejections – 35 USC § 103,” item 10-12 on page 6 of the above-identified Office Action, claims 1 and 15 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,058,036 (hereinafter *Yu*) in view of *Greene*.

The rejection has been noted and claim 1 has been amended. As amended, claim 1 claims a method performed by instant messaging clients, comprising:

- first receiving, by a first instant messaging client, a first location of the first instant messaging client;
- second receiving, by a first instant messaging client, from the instant messaging server a second location of a second instant messaging client;
- determining, by the first instant messaging client, a proximity of the first and second locations; and
- automatically executing an application program, by the first instant messaging client, if the proximity meets a pre-determined threshold.

Supports for the changes made to claim 1 can be found on page 7 of the specification of the instant application.

In contrast to amended claim 1, *Yu* discloses transmissions of identification by IM clients during communication with an IM sever. *Greene* discloses that IM clients determine their locations and transmit the location information to the IM server, the IM server automatically translating the position data to a location tag. *Greene* also discloses that IM clients receive location information of other clients from the IM server. Thus, at best, *Yu* and *Greene* suggest an IM client that is capable of receiving its own location and another client's location, and an IM server capable of automatically executing an application (translating the position to the tag) in response to receiving a location.

Neither *Yu* nor *Greene* teach or suggest, however, determining a proximity of the two locations and automatically executing an application based on whether that proximity meets a threshold. *Yu* and *Greene* have no notion of proximity, and only suggest the IM server automatically executing an application, not the IM clients. *Yu* and *Green* provide no detail as to what the IM clients do with the locations once they are received. No discussion is made of any determinations made by the clients based on the locations, or of any actions taken based on results of such determinations.

To establish prima facie obviousness the Examiner must show where in the combined references support may be found, in the form of teaching or suggestion, for each limitation. The mere mention of IM clients receiving each other's locations, without more, simply suggests that each client is aware of the other's location and perhaps shares the location with its user. It provides absolutely no support for further steps, such as determining proximity and automatically executing an application based on the proximity.

Accordingly, claim 1 is patentable over *Yu* and *Greene*, alone or in combination, under 35 USC §103. Similar arguments can be applied to the amended claim 15 as well. So claim 15 is also patentable over *Yu* and *Greene* under 35 USC §103.

2. In “Claim Rejections – 35 USC § 103,” item 13-29 on page 6-10 of the above-identified Office Action, claims 3-7, 10, 13, 14, 17, 18, and 21 have been rejected under 35 USC §103 as being obvious over *Yu and Greene*.

Claims 3, 4, 10, 13, 14, 17, 18 and 21 have been cancelled, obviating the Examiner’s rejections.

Claims 5-7 depend on amended claim 1 and incorporate all its limitations. Therefore, for at least the same reasons that claim 1 is patentable over Yu and Greene, claims 5-7 are also patentable.

3. In “Claim Rejections – 35 USC § 103,” item 31-36 on page 10-12 of the above-identified Office Action, claims 2, 11, 12, 16, 19 and 20 have been rejected under 35 U.S.C. § 103(a) as being obvious over *Yu, Greene* and U.S. Patent Application Publication 2002/0107027 (hereinafter *O’Neil*).

Claims 11, 12, 19 and 20 have been cancelled, obviating the Examiner’s rejections.

Claim 2 depends on claim 1 and incorporates all its limitations. *O’Neil* does not remedy the aboved discussed deficiency of *Greene*. Therefore, claim 2 is patentable over *Yu, Greene* and *O’Neil* under 35 USC §103.

4. In “Claim Rejections – 35 USC § 103,” item 37-40 on page 12-13 of the above-identified Office Action, claims 8 and 9 have been rejected under 35 U.S.C. § 103(a) as being obvious over *Yu, Greene* and U.S. Patent Publication 2004/0122810 (hereinafter *Mayer*).

Claims 8 and 9 depend on claim 1 and incorporate all its limitations. *Mayer* does not remedy the aboved discussed deficiency of *Greene*. Therefore, claims 8 and 9 are patentable over *Yu, Greene* and *Mayer* under 35 USC §103.

5. In "Claim Rejections – 35 USC § 103," item 41-45 on page 13-14 of the above-identified Office Action, claim 23 has been rejected under 35 USC § 103(a) as being obvious over *Greene, O'Neil* and U.S. Patent Application Publication 2002/0184089 (hereinafter *Tsou*).

Claim 23 depends on claim 22 and incorporate all its limitations. *O'Neil* and *Tsou*, alone or in combination, do not remedy the aboved discussed deficiency of *Greene*. Therefore, claim 23 is patentable over *Greene, O'Neil* and *Tsou* under 35 USC §103.

CONCLUSION

In view of the foregoing, reconsideration and allowance of claims 1, 2, 4-9, 15, 16, and 22-24 are solicited. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: 10/17/07

by: / Robert C. Peck/
Robert C. Peck
Reg. No.: 56,826

Schwabe, Williamson & Wyatt, P.C.
Pacwest Center, Suites 1600-1900
1211 SW Fifth Avenue
Portland, Oregon 97222
Telephone: 503-222-9981